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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,864	02/19/2004	Klaus Kadel	1461.0060001/TUM/MJM	1964
26111	7590	11/18/2004	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PATEL, MITAL B	
			ART UNIT	PAPER NUMBER

3743

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,864

Applicant(s)

KADEL ET AL.

Examiner

Mital B. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☒ Certified copies of the priority documents have been received in Application No. 09/509,201.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/3/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Please note that the Declaration field 2/19/04 has the residence and post office address of Mr. Kadel stricken on the left block and re-written with a different residence and post office address in the right block, however, there are no initials next to the changes made in the right block.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally **limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.** The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1; 2; 3; 4; 6; 7; 9; 9; 9; 10; 11; 12; 13; 13; 14; 15; 16; 18; 19; 20; 21; 22; 22; 22; 23; 1, 24; and 25 respectively of copending Application No. 09/509201 (Please note Application No. 09/509201 has been allowed, however, the Application has not been assigned a patent number and as such the double patenting rejection is a provisional rejection). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application claims are merely broader than the claims of Application No. 09/509201. Since the claims of Application No. 09/509201 are more specific than those of the instant application, the claims of Application No. 09/509201 anticipate the broader claims of the instant application. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. **Claim 1 of the instant application** recites "a microstructured filter having an inlet for unfiltered fluid and an outlet for filtered fluid, the filter comprising" (**See Claim 1,**

lines 1-2 of Application No. 09/509201), “a substantially flat base plate having a plurality of projections extending therefrom such that each projection is an integral component of the base plate, wherein the projections are spaced from one another by passages that form a fluid path through the filter from the inlet to the outlet” (**See Claim 1, lines 4-6 of Application No. 09/509201**), and “a cover plate securable to the base plate for covering the projections and the passages” (**See Claim 1, lines 7-8 of Application No. 09/509201**), “wherein the plurality of projections are arranged in at least two rows to extend in a zig-zag configuration and in a mutually juxtaposed relationship across the filter” (**See Claim 1, lines 9-11 of Application No. 09/509201**). The difference between Claim 1 of the instant application and claim 1 of Application No. 09/509201 lies in the fact that the claim of Application No. 09/509201 includes additional elements and is thus more specific. Thus the invention of claim 1 of Application No. 09/509201 is in effect a “species” of the generic invention of claim 1 of the instant application. Thus the generic invention is “anticipated” by the “species” and is not patentably distinct. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993)

6. **As to claim 2 of the instant application**, the limitations can be found in claim 2 of Application No. 09/509201.

7. **As to claim 3 of the instant application**, the limitations can be found in claim 3 of Application No. 09/509201.

8. **As to claim 4 of the instant application**, the limitations can be found in claim 4 of Application No. 09/509201.

9. **As to claim 5 of the instant application**, the limitations can be found in claim 6 of Application No. 09/509201.
10. **As to claim 6 of the instant application**, the limitations can be found in claim 7 of Application No. 09/509201.
11. **As to claim 7 of the instant application**, the limitations can be found in claim 9 of Application No. 09/509201.
12. **As to claim 8 of the instant application**, the limitations can be found in claim 9 of Application No. 09/509201.
13. **As to claim 9 of the instant application**, the limitations can be found in claim 9 of Application No. 09/509201.
14. **As to claim 10 of the instant application**, the limitations can be found in claim 10 of Application No. 09/509201.
15. **As to claim 11 of the instant application**, the limitations can be found in claim 11 of Application No. 09/509201.
16. **As to claim 12 of the instant application**, the limitations can be found in claim 12 of Application No. 09/509201.
17. **As to claim 13 of the instant application**, the limitations can be found in claim 13 of Application No. 09/509201.
18. **As to claim 14 of the instant application**, the limitations can be found in claim 14 of Application No. 09/509201.
19. **As to claim 15 of the instant application**, the limitations can be found in claim 14 of Application No. 09/509201.

20. **As to claim 16 of the instant application**, the limitations can be found in claim 15 of Application No. 09/509201.
21. **As to claim 17 of the instant application**, the limitations can be found in claim 16 of Application No. 09/509201.
22. **As to claim 18 of the instant application**, the limitations can be found in claim 18 of Application No. 09/509201.
23. **As to claim 19 of the instant application**, the limitations can be found in claim 19 of Application No. 09/509201.
24. **As to claim 20 of the instant application**, the limitations can be found in claim 20 of Application No. 09/509201.
25. **As to claim 21 of the instant application**, the limitations can be found in claim 21 of Application No. 09/509201.
26. **As to claim 22 of the instant application**, the limitations can be found in claim 22 of Application No. 09/509201.
27. **As to claim 23 of the instant application**, the limitations can be found in claim 22 of Application No. 09/509201.
28. **As to claim 24 of the instant application**, the limitations can be found in claim 22 of Application No. 09/509201.
29. **As to claim 25 of the instant application**, the limitations can be found in claim 23 of Application No. 09/509201.
30. **Claim 26 of the instant application** recites "a nebulizer for inhalation therapy, the nebulizer comprising a microstructured filter having an inlet for unfiltered fluid and

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an outlet for filtered fluid, the filter comprising" (**See Claim 1, lines 1-2 of Application No. 09/509201 and Claim 24, lines 1-3 of Application No. 09/509201**), "a substantially flat base plate and a cover plate securable thereto" (**See Claim 1, line 3 of Application No. 09/509201 and Claim 24, lines 4-5 of Application No. 09/509201**), "a plurality of projections that each comprise an integral component of the base plate and which each project therefrom, the projections being spaced from one another by passages that form a fluid path through the filter from the inlet to the outlet" (**See Claim 1, lines 4-6 of Application No. 09/509201 and Claim 24, lines 6-10 of Application No. 09/509201**), "the cover plate when secured to the base plate covering the projections and the passages" (**See Claim 1, lines 7-8 of Application No. 09/509201 Claim 24, lines 6-10 of Application No. 09/509201**), "wherein the plurality of projections are arranged in at least two rows in a mutually juxtaposed relationship across the filter" (**See Claim 1, lines 11-13 of Application No. 09/509201**). It should be noted that with respect to the double patenting rejection of claim 26 of the instant application with claim 1 of Application No. 09/509201, the Examiner has not given patentable weight to the preamble of claim 26 of the instant application which sets forth a nebulizer. There is no structure associated with the nebulizer other than that of the filter which is met by the limitations of claim 1 of Application No. 09/509201. As to the double patenting rejection of claim 26 of the instant application with claim 24 of Application No. 09/509201, the Examiner recognizes that claim 24 of Application No. 09/509201 does not set forth a zig-zag configuration. However, the use of a zig-zag configuration is well known in the filter art and therefore, it would have been obvious to

one of ordinary skill in the art to provide such a configuration in the filter of the instant application.

31. **As to claim 27 of the instant application**, the limitations can be found in claim 25 of Application No. 09/509201.

Conclusion

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6732868 and US 2003/0121845.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mital B. Patel whose telephone number is 703-306-5444. The examiner can normally be reached on Monday-Friday (11:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 703-308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Mital B. Patel
Examiner
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